

08/750,715



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/750,715	03/19/97	EIGEN	P60752USQ

EXAMINER

MM41/0819

JACOBSON PRICE HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY CO
400 SEVENTH STREET NW
WASHINGTON DC 20004

NOT APPLICANT PAPER NUMBER

2856

DATE MAILED: 08/19/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 6/1/98 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 33-66 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-32 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 2856

1. The amendment filed June 1, 1998 has been entered.
2. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2856.
3. Claims 33-66 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood from page 6, lines 2-14 or elsewhere in the disclosure how the generated signal defines the volume element, determines the time to transfer the volume element, and controls the transfer as set forth in claim 1. How this is done does not appear to be readily apparent to one of ordinary skill in the art. It is unclear if applicant is relying on PCT/EP94/00117 for this.
4. To be in better form in claim 33, line 5 "said" should be -- the --. In line 7 "to" should be -- to the --. In line 9 -- -- another environment -- -- is misspelled. In line 10 --- component --- is. In line 11 -- environment --- is. In claim 34, line 3 --- apertures --- is misspelled. In line 4 "by" should be --- by a ---. In line 5 "to" should be --- to the ---. In claim 37, line 2 "said wall" should be --- the wall --. In claim 38, line 1 "said" should be -- the -- and "the" should be -- an --. In claim 39, line 1 " the " should be deleted. Correction is required.

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5. Claims 36, 38-41, 43, 44, 48-52, 54-59, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claiming of alternatives as in claim 36 is unclear. It should be written in Markush type language. Limitations such as "and/or" as in claim 38, line 3 and claim 39, line 5 are unclear. It is unclear what is meant by "is in electrically contacts" in line 5 of claim 38. In claim 39, line 5 "the other environment receptor compartment" should be -- a receptor compartment in the other environment ---. It is unclear what is meant by "claims 2" in claim 43, line 1; "claim 44" in claim 44, line 1, "and " is a which " in claim 48, line 1. Claim 48 also is unclear because the alternative claiming therein is confusing. Likewise for claim 49 which is also unclear because it is unknown what is meant by "claim 336" in line 1. Claims 51 and 52 are unclear because of the alternative claiming. Likewise claims 54-56. Claim 55 is also unknown because it is unclear what is meant by 'claim 55" in line 1. Likewise it is unclear what is meant by "claim 57" in claim a 57, line 1, by "claim 2" in claim 58, line 1; or claim 59" in claim 59, line 1. Claims 58 and 59 are also unclear since dependent claims but claiming a device when base claims were directed to a method. It is unclear what is meant by "preferably" in claim 59, line 6. The alternative claiming in 63 is unclear.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Eigen et al.

Note specially the abstract and the first two text paragraphs on pages 5740 and 5741. Applicants statement that the claims as amended overcome all rejections was noted but since at

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least claim 33 appears broader than claim 1 and thus Eigen et al would appear to still anticipate claim 33.

7. Claims 33-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al, Ashkin et al, North, Jr., Gohde et al., or Weber et al.

The reasons are substantially equivalent to those given in paragraph 13 in the prior Office actions since any differences appear to be known or obvious to one of ordinary skill in the sample handling and analysis arts since similar such techniques are known therein.

8. Applicant's arguments filed June 1, 1998 have been fully considered but they are not persuasive. Applicants statement that the claims as amended overcome the rejections have been noted but since essentially claiming the same invention the claims appear to be rejectable at least under 35 U.S.C. 112(1), 102, and 103 for reasons substantially equivalent to those set first in the last office action.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Noland/ds
08/17/98

Serial Number: 081750, 715

Final Page

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (703) 305-4765.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

8/10/81

Thomas P. Noland
Primary Examiner
Art Unit 2856

Tom Noland